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2

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,540	09/27/2001	Hiroshi Ogino	80398.P460	4648

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EXAMINER

HEWITT II, CALVIN L

ART UNIT PAPER NUMBER

3621

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/966,540

Applicant(s)

OGINO, HIROSHI

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Status of Claims***

1. Claims 1-29 have been examined.

***Claim Rejections - 35 USC § 112***

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2. The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7-13 and 13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites, a "privacy system comprising a secure mechanism..." However, claim 7 is dedicated to a transaction device that does not comprise or contain a "privacy system".

Claims 8-13 are also rejected as they depend from claim 7.

Claim 15 recites the limitation "the transaction privacy clearinghouse" in line 2. Claims 16 and 17 recite "the electronic commerce transaction" in line 1. There is insufficient antecedent basis for these limitations in the claims.

Claims 16 and 17 are also rejected as they depend from claim 15.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 6-11, 13, 14 and 26 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Buckley et al., U.S. Patent No. 6,446,871.

As per claims 1-4, 6-11 and 13 the MPEP (2144) is clear,

while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of *structure* rather than function alone (*italics added*)

Therefore (claims 1-4 and 6), as Walsh et al. clearly disclose a transaction device (figure 3E; column/line 4/48-5/8) comprising a sensor module (e.g. barcode reader) (column 5, lines 9-37; column 6, lines 12-19) and a communication module (figures 4 and 5), that are configured to receive (e.g. product information) (figure 9; column 8, lines 27-44) and transmit data to servers (figures 4, 5, 8 and 9; column 9, lines 8-64 or inherently

DNS, caching, and/or proxy servers), respectively. The device also receives data from servers based on the product identification (figures 4, 5, 8 and 9; column 10, lines 14-65), makes requests to purchase a product without providing an identifier of the user (column/line 5/62-6/13), stores retrieved product data (figure 9; column 10, lines 7-39; column/line 10/55-11/26).

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As per claims 7-11, and 13 Buckley et al. teach a transaction device comprising a sensor module (for reading product information from a product tag) (figures 1-3E), wireless module (figures 1-3E; column 4, line 55-61), a communication module (abstract; figures 4 and 5), and a display module for displaying received information (figure 9). Buckley et al. also teach an electronic transaction device that can purchase products from a vendor through a secure mechanism using the wireless and communication module (column/line 5/62-6/13; column 9, lines 7-25).

As per claims 14 and 26, Buckley et al. teach receiving at a transaction device, a signal based on a product tag associated with a product (figures 4, 5, 8 and 9), transmitting the product tag to a product server through a privacy server (figure 4) indicating a request of product information based on the product tag without providing an identity of the user (figures 4 and 5) and receiving product information from the product server (figure 9).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al., U.S. Patent No. 6,446,871 in view of Ausems et al., U.S. Patent No. 6,434,403.

As per claims 5 and 12, Buckley et al. teach a transaction device comprising a data acquisition device and a computer for transmitting acquired data to a site on the internet (figures 4, 5, 8 and 9). However, Buckley et al. do not specifically recite a privacy card, digital wallet, nor a privacy card configured to be coupled to a wallet. Ausems et al. teach a portable computer such as a privacy card (column 6, lines 53-59) for transmitting data over the internet (figure 2; column/line 5/65-6/8; column 7, lines 9-20; column/line 7/62-8/6). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Buckley et al. into the portable device of Ausems et al. ('871, column 11, lines 27-37) in order allow users (e.g. traveling salesman-'871, column 5, lines 62-67) to conduct business while on route to a destination.

7. Claims 15, 17, 18, 20-25, 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al., U.S. Patent No. 6,446,871 in view of Walker et al., U.S. Patent No. 6,163,771.

As per claims 15, 17, 18, 20-25, 27 and 29, Buckley et al. teach a transaction device for making purchases over the internet from a vendor (column/line 5/62-6/13; column 9, lines 8-25) using a transaction device and a server. However, Buckley et al. do not specifically recite using device identifiers. Walker et al. teach a secure method for making purchases over the internet using a device (privacy card, or digital wallet or privacy card coupled to a digital wallet-'771, abstract, figures 1 and 2) identifier and a user account to communicate with a privacy server comprising a database for authorizing a transaction, and wherein the user identity is unknown to a seller (figures 3A-B, 8 and 9B; column/line 6/60-7/20; column/line 7/45-8/65). Walker et al. also teach a privacy server coupled to, or comprising a financial institution (figure 4). Therefore, it would have been obvious to combine the teachings of Buckley et al. and Walker et al. in order to protect a user from credit card theft ('771, column 2, lines 35-61).

8. Claims 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al., U.S. Patent No. 6,446,871 and Walker et

al., U.S. Patent No. 6,163,771 as applied to claim 15 above, and in further view of Peckover, U.S. Patent No. 6,119,101.

As per claims 16, 19, and 28 Buckley et al. teach purchases over the internet using product tag data (figures 4, 5, 8 and 9; column/line 5/62-6/13; column 9, lines 8-25). Walker et al. teach secure transaction over the internet using device identifiers (abstract). However, neither Buckley et al. nor Walker et al. teach receiving coupons. To one of ordinary skill a coupon is a form of advertisement. Peckover teaches a system where users, whose specific identity is unknown to the vendor (figure 4A), make queries regarding desired products and or information (column 15, lines 10-63; column/line 27/51-29/57) are able to receive digital advertisements and other messages from sellers through a third party device (e.g. privacy server) (abstract; figure 1). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Buckley et al., Walker et al. and Peckover in order to allow vendors to target specific advertisements to desired users ('101, abstract; column/line 35/63-37/40)

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:



- Teicher discloses digital wallets and smart cards
- Walsh teaches a handheld device for reading and transmitting barcodes comprising purchase information

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10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
c/o Technology Center 2100  
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Art Unit: 3621

Hand-delivered responses should be brought to Crystal Park 5,  
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this  
application should be directed to the Group receptionist whose telephone  
number is (703)

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308-1113.

  
Calvin Loyd Hewitt II  
August 8, 2004